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GP 2833

402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy :  
Title: Retractable Receptacle For : Examiner: B. Hammond  
Furniture : Group Art Unit: 2833  
Serial No. 08/951,276 :  
Filed: October 16, 1997 :

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5/19/00

Hon. Commissioner of Patents & Trademarks  
Washington, D.C. 20231

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REPLY BRIEF

Applicant hereby replies to the Examiner's Answer mailed on April 11, 2000, in response to Applicant's Appeal Brief filed on January 19, 2000.

Applicant initially notes that the first page of the Examiner's Answer bears a stamp indicating that it was mailed on March 11, 2000. This is erroneous because the printed Patent & Trademark Office cover sheet accompanying the Examiner's Answer indicates that the document was mailed on April 11, 2000. The

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(Date of Deposit)

Mark P. Stone  
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Reg. N . 27,954

document was first received by the undersigned on April 17, 2000 in an envelope postmarked April 13, 2000. Accordingly, the final date for filing this Reply Brief is June 11, 2000.

At page 2 (paragraph 6) and at page 4 of the Examiner's Answer, the Examiner has withdrawn all rejections made under 35 U.S.C. Sections 102 and 103. Accordingly, the only outstanding grounds of rejection remaining in this Appeal are the rejections under 35 U.S.C. Section 112, first paragraph (See page 3, paragraph 9 of the Examiner's Answer). Referring to page 3, paragraph 10 of the Examiner's Answer, the pending claims stand rejected under 35 U.S.C. Section 112, first paragraph, based upon "lack of written description". The Examiner's Answer expressly acknowledges that no grounds of rejection are based upon lack of enablement.

It is well established that the standard for determining compliance with the written description requirement of 35 U.S.C. Section 112, first paragraph is whether the description clearly allows persons of ordinary skill in the art to recognize that the Applicant has invented what is claimed. See, for example, In re Gosteli, 10 USPQ 2d 1614 (Fed. Cir. 1989). An Applicant's specification must convey with reasonable clarity to those skilled in the art that, as of the filing date of the application, that the Applicant was in possession of the invention as claimed. Vas-Cath, Inc. v. Mahurkar, 19 USPQ 2d 1111 (Fed. Cir. 1991). The Patent & Trademark Office has the initial

burden of presenting evidence or reasons why persons skilled in the art would not recognize a description of the invention defined by Applicant's claims in Applicant's disclosure. In re Wertheim, 191 USPQ 90 (CCPA 1976).

The Examiner's Answer, at page 3, paragraph (10), incorporates by reference the rejection based on "lack of written description" from the Official Action dated August 31, 1999 (Paper No. 8), and states "...Appellant has not pointed out whether a written description of these claim recitations are found in the disclosure." Applicant respectfully submits that the specification of the patent application as originally filed provides a clear written description of each of the "terms/elements" identified by the Examiner at page 3, paragraph 5 of the Official Action dated August 31, 1999. The description of each of these "terms/elements" in Applicant's original specification can be found as follows:

1. "Means for coupling said housing" - none of the pending claims recite "means for coupling said housing". However, Claim 20 recites "said housing includes means for coupling said receptacle unit to an external power source", and Applicant assumes that the Official Action intended to refer to such means. Support for this claim recitation can be found in Applicant's specification at page 6, lines 16 - 19; and at page 10, last line through page 11, line 4;

2. The claim recitation "means for resiliently biasing" is found in Applicant's specification at page 6, lines 20 - 22; page 11, lines 7 - 8; page 11, line 20; page 12, second paragraph, line 11;

3. The claim recitation "means for selectively displacing the receptacle unit" is found in Applicant's specification at page 11, lines 10 - 21; page 13, last paragraph, line 1 through page 14, first paragraph, line 3; and page 14, second paragraph, lines 5 - 8;

4. The claim recitation of "open top" of the housing is found at page 6, lines 14 - 16; and page 10, second paragraph, lines 1 - 4;

5. The claim recitation "means for biasing the receptacle unit" is found in Applicant's specification at page 6, lines 19 - 21; page 11, lines 7 - 8; and page 11, line 20; and

6. The claim recitation "locking means" is found in Applicant's specification at page 6, lines 21 - 24; page 11, lines 8 - 10; page 11, lines 17 - 19; page 12, second paragraph, lines 10 - 14; and page 14, lines 5 - 7.

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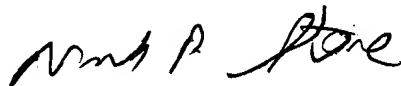
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Applicant respectfully submits that the original specification of the patent application fully describes and supports each of the claim recitations referred to at paragraph 5

of the Official Action dated August 31, 1999. Accordingly, all outstanding grounds of rejection raised in the Examiner's Answer have been obviated, and this application is in condition for allowance.

Applicant respectfully requests that the rejection of the claims in the Examiner's Answer be reversed, and that this application be allowed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mark P. Stone".

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